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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,740	02/27/2004	James C. Vanous	86193SLP	8410

7590 04/05/2006

Pamela R. Crocker
Patent Legal Staff
Eastman Kodak Company
Rochester, NY 14650-2201

EXAMINER	
CHEA, THORL	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/789,740	VANOUS ET AL.	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *16-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to the communication January 23, 2006; claims 1-18 are pending in this instant application; claims 16-18 are withdrawn from consideration as being drawn to non-elected invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification disclosure fails to provide an adequate written description as how to produce a photothermographic material when thermally produced provide an area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermopaphic material.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shoji (US Patent No. 6,569,614).

See photothermographic material that having Dmin and Dmax after thermally processing. See Figs. 3-6 on sheet 2-3 and Dmin and Dmax in column 8, lines 17-67, wherein Dmin $\leq$ 0.25 and Dmax $\geq$ and 2.5, and Fig. 6 which discloses a region that has density less than Dmax and greater than Dmin. Shoji et al may not disclose whether an area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material as claimed. However, this area is inherent to the photothermographic material taught in Shoji that inherently produce the density Dmin, Dmax and an area having density between Dmin and Dmax. Therefore, the area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material as claimed is inherent to the material and the process taught in Shoji. In the absence of showing in the contrary, it is asserted that the invention as claimed is either anticipated by or would have been found prima facie obvious over the disclosure of Shoji.

7. Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0600586B1 (EP'586).

See EP'586 as a whole especially the samples in Tables 1-7 on pages 9-22; pages 2, lines 34-57 to page 3, lines 1-20, and page 12, example 28 wherein the protective topcoat layer containing isocyanate; and the binder on pages 7, liners 49-54 including methacrylate copolymers. EP'586 may not disclose whether an area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material as claimed. However, this area is inherent to the photothermographic material taught in EP'586 that inherently produce the density Dmin, Dmax and an area having density between Dmin and Dmax. Therefore, the area disposed along a length of at least one edge of the photothermographic material, the area having an optical density less than the Dmax and greater than the Dmin of the photothermographic material as claimed is inherent to the material and the process taught in EP'586 due to the similarity of the composition and inherently produce Dmin and Dmax. . In the absence of showing in the contrary, it is asserted that the invention as claimed is either anticipated by or would have been found prima facie obvious over the disclosure of EP'586.

Response to Arguments

8. Applicant's arguments filed January 23, 2006 have been fully considered but they are not persuasive for the reason set forth in the rejection above. The rejection under 35 USC 112 first and second paragraphs are maintained since the applicants fails to clearly response to the rejection above. The issue presented in the previous office action is that the specification does not teach the photothermographic material before processing wherein the at least one edge of the

photothermographic material has an optical density less than the Dmax and greater than Dmin. There is no change or modification of the photothermographic composition along the edge of the sheet. The material has same or similar composition to that the material taught in the prior art of record which a support coated with thermal developable layer. The applicants fails to provide a clear response to the previous office action whether the invention as claimed is directed to the material after processing containing the Dmin, Dmax and Dmid or the photothermographic material before processing. During the prosecution, the Examiner considered the photothermographic material before processing wherein the applied prior art discloses a photothermographic material having thermal-developable layer before processing which is a material before exposure. The limitation in claim 1 "an area which is disposed along the edge of at least one edge of the photothermographic material, and which when exposed and thermally processing by a thermal processor, has an optical density less than the Dmax and greater than the Dmin of the photothermographic material" can be achieved when exposed and thermally processing by thermal processor, but not by the nature of the photothermographic material before processing. The density of along the length of at least one edge of the photothermographic material can be achieved not by the material alone but the combination with the process. The applicants fail to show that the material taught in the applied prior art fails to inherently produce such Dmin, Dmax or Dmid presented in the argument in the case where the same process is used. The applicants'argument is related to the problem solving of the material known in the prior art but fails to differentiate as to why the material of the applied prior art differs that of the claimed material.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tch
March 31, 2006

Thorl Chea
Primary Examiner
Art Unit 1752